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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,282	08/31/2001	Lucas Merrow	57622-048 (ELZK-8)	3806

7590 08/25/2004

McDermott, Will & Emery  
28 State Street  
Boston, MA 02109

EXAMINER
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ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/945,282	<b>Applicant(s)</b> MERROW ET AL.	
	<b>Examiner</b> Md S Elahee	<b>Art Unit</b> 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/19/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments mailed on 07/19/04 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

### ***Objections to Amendments to Specification***

2. The disclosure of the replacement paragraph filed on 07/19/04 is objected to because of the following informalities: the replacement paragraph or section must be a marked-up version showing the changes.

Appropriate correction is required.

### ***Objections to Amendments to Claim***

3. The claims currently amended filed on 07/19/04 are objected to because of the following informalities: the claims must include markings (strikethrough, double brackets, or underlining) to indicate changes.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-14 and 16-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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possession of the claimed invention. Regarding claim 1, the added limitation "semantic meaning of said spoken response" on page 4 is not disclosed in the original specification.

Regarding claims 1-4, 6-14 and 16-21 are rejected for the same reasons as discussed above with respect to claim 1.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 7, 11, 17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ljungqvist et al. (International Pub. No. WO 98/52340).

Regarding claims 1 and 11, Ljungqvist teaches placing, with a control node, a call (i.e., telephone call) to a location having a telephone number associated with a subscriber (i.e., target person) contained in a predetermined list of one or more telephone numbers and associated subscribers (page 7, lines 14-16, 21-26, page15, lines 1-9; 'control node' reads on the claimed 'automated calling system').

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Ljungqvist further teaches that upon the call being answered, supplying an introductory message (i.e., prerecorded greeting) which asks for the subscriber (fig. 3, 4; page 18, lines 11, 12, page 19, lines 6-15).

Ljungqvist further teaches receiving an answer (i.e., spoken response) from a subscriber (i.e., answering party) (fig.4, item 443).

Ljungqvist further teaches performing inherently a speaker-independent speech recognition analysis on the answer to determine a semantic meaning of the answer (fig.4, item 443; page 15, lines 9-14, page 19, lines 18-23).

Ljungqvist further teaches if the speaker-independent speech recognition analysis determines that the subscriber is the target person, initiating a speaker-independent speech recognition application with the target person (page 18, lines 11, 12, page 19, lines 6-23).

Regarding claims 7 and 17 are rejected for the same reasons as discussed above with respect to claim 1.

Regarding claim 21(A)-21(E) is rejected for the same reasons as discussed above with respect to claim 1. (Note: since in 21(E) at least one of the following responses is determined by said speaker-independent speech recognition analysis, only option 'a' is rejected with respect to claim 1)

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ljungqvist et al. (International Pub. No. WO 98/52340) and in view of Bartholomew et al. (U.S. Patent No. 6,167,119).

Regarding claims 2 and 12, Ljungqvist fails to teach, "if said speech recognition analysis determines that said spoken response indicates that said answering person is not said target person, a next step comprises initiating a prerecorded query asking for said target person". Bartholomew teaches that if voice authentication module determines that the spoken response indicates that the answering party is not the called subscriber, a next step comprises asking for the harassed party (col.44, lines 1-12, col.45, lines 28-52; 'voice authentication module' reads on the claim 'speech recognition analysis', 'the answering party is not the called subscriber' reads on the claim 'said answering person is not said target person' and 'asking for the harassed party' reads on the claim 'initiating a prerecorded query asking for said target person'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow speech recognition analysis determining that the answering person is not said target person as taught by Bartholomew. The motivation for the modification is to have the speech recognition analysis in order to make sure that the target person is answering the phone.

Regarding claims 3 and 13, Ljungqvist further teaches upon the target person answering the telephone call, the method further comprises initiating a speaker-independent speech recognition application with the target person (fig.4, item 443; page 15, lines 9-14, page 19, lines 18-23).

Regarding claims 4 and 14, Ljungqvist further fails to teach, "said target person is not present at said location, a next step comprises initiating a prerecorded query asking to leave a message for said target person". Bartholomew teaches that the called subscriber is not answering the telephone, a next step comprises initiating an answering prompt message to the caller to record a message from the caller (col.44, lines 1-12, 31-63, col.45, lines 28-52, col.47, lines 33-39; 'the called subscriber is not answering the telephone' reads on the claim 'said target person is not present at said location' and 'an answering prompt message to the caller to record a message from the caller' reads on the claim 'a prerecorded query asking to leave a message for said target person'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow initiating a prerecorded query asking to leave a message for said target person as taught by Bartholomew. The motivation for the modification is to have the initiation in order to record the message for later retrieval.

Regarding claims 5 and 15, Ljungqvist further teaches supplying an introductory message (i.e., prerecorded greeting) to the subscriber (i.e., answering person) (fig. 3, 4; page 18, lines 11, 12, page 19, lines 6-15).

Regarding claims 6 and 16, Ljungqvist further fails to teach, "if said speech recognition analysis determines that said spoken response is a hold request, a next step comprises entering a wait state to wait for said target person to provide a spoken response to said telephone call". Bartholomew teaches if voice authentication module determines that the spoken response is a hold request, a next step comprises entering a hold sequence to wait for the answering party to provide a spoken response to the telephone (col.44, lines 1-12, 31-63, col.45, lines 28-52, col.46, lines 1-5, col.47, lines 53-67; 'voice



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authentication module' reads on the claim 'speech recognition analysis', 'hold sequence' reads on the claim 'wait state', 'answering party' reads on the claim 'target person' and 'telephone' reads on the claim 'telephone call'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow spoken response as a hold request as taught by Bartholomew. The motivation for the modification is to have the hold request in order to get the target person.

9. Claims 8, 10, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ljungqvist et al. (International Pub. No. WO 98/52340) and in view of Miner et al. (U.S. Patent No. 5,652,789).

Regarding claims 8 and 18, Ljungqvist fails to teach "if said speech recognition analysis determines that said spoken response is a request for the identity of the entity responsible for the calling system, the method further comprises initiating a prerecorded response indicating the identity of the calling party". Miner teaches the system attempting to recognize the caller by playing prerecorded response (col.7, lines 18-37). If the system succeeds in recognizing the caller on the basis of his phone number, it then plays the prerecorded message and stores the identity of the contact (col.7, lines 38-50). It then attempts to locate the subscriber (col.7, lines 51-56). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow the system to identify the entity responsible for the calling system and to initiate a prerecorded response indicating the identity of the calling party as taught by Miner. The motivation for the modification is to allow the calling system to provide identity of the calling party and the target person.

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Regarding claims 10 and 20, Ljungqvist fail to teach "if said speaker-independent speech recognition analysis cannot determine a status of said spoken response, said method further comprises repeating, said prerecorded greeting which asks for the target person". Miner further teaches electronic assistant mediating the connection when a contact tries to reach the subscriber (col.2, lines 20-22) and performing a speaker-independent speech recognition analysis on spoken response of the subscriber (col.6, lines 26-37). If the subscriber is not accepting any calls (col.7, lines 66,67), the system plays a prerecording message (col.8, lines 1,2). The system may also send a message notifying the subscriber of the call and identifying the caller (col.8, lines 33-35). Then the subscriber has the option of accepting the call, asking the system to place the caller on hold while he completes his present call (col.8, lines 36-39). When the subscriber has completed his other call, he instructs the system to establish a direct connection with the new caller (col.8, lines 40-49). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow the system to repeat prerecorded greeting which asks for the target person if the speaker-independent speech recognition analysis cannot determine a status of spoken response as taught by Miner. The motivation for the modification is to allow the calling system to make sure the availability of the target person.

10. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ljungqvist et al. (International Pub. No. WO 98/52340) and in view of Szlam et al. (U.S. Patent No. 5,828,731).

Regarding claims 9 and 19, Ljungqvist fail to teach "said telephone number is not the correct number for the target person, the method further comprises initiating a

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prerecorded apology message and terminating said telephone call”. Szlam teaches that a wrong number was made, the method further comprises playing an apology message and terminating the call terminating the call (col.2, lines 51-58, fig. 2B; ‘a wrong number was made’ reads on the claim ‘said telephone number is not the correct number for the target person’ and ‘playing an apology message and terminating the call terminating the call’ reads on the claim ‘initiating a prerecorded apology message and terminating said telephone call’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to play an apology message as taught by Szlam. The motivation for the modification is to have initiating a prerecorded apology message in order to generate an apology message to the call recipient for apologizing for the wrong call.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ljungqvist et al. (International Pub. No. WO 98/52340) and in view of Bartholomew et al. (U.S. Patent No. 6,167,119).

Regarding claim 22 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Ljungqvist does not specifically teach, “waiting for a predetermined time period for a spoken response”. Bartholomew teaches waiting for the answering party to provide a spoken response to the telephone (col.44, lines 1-12, 31-63, col.45, lines 28-52, col.47, lines 53-67, col.46, lines 1-5; ‘waiting for the answering party’ reads on the claim ‘waiting for a predetermined time period’ and ‘telephone’ reads on the claim ‘telephone call’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow waiting for a predetermined time period for a spoken response as taught by Bartholomew. The

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motivation for the modification is to have the waiting request in order to get the target person.

Ljungqvist further fails to teach, “while playing said prerecorded greeting prompt, attempting to detect a further spoken response in excess of a predetermined time parameter”. Bartholomew teaches while playing the instruction, attempting to detect a further spoken response in excess of a holding time (col.44, lines 1-12, 31-63, col.45, lines 28-52, col.46, lines 1-5; ‘instruction’ reads on the claim ‘prerecorded greeting prompt’ and ‘holding time’ reads on the claim ‘predetermined time parameter’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow attempting to detect a further spoken response in excess of a predetermined time parameter as taught by Bartholomew. The motivation for the modification is to have the detection in order to get the spoken response of the target person.

Ljungqvist further fails to teach, “in the absence of detecting said further spoken response during the playing of said prerecorded greeting prompt, initiating a query application”. Bartholomew teaches in the absence of detecting the further spoken response during the playing of the instruction, initiating a call handling instruction (col.44, lines 1-12, 31-63, col.45, lines 28-52, col.46, lines 1-5; ‘instruction’ reads on the claim ‘prerecorded greeting prompt’ and ‘call handling instruction’ reads on the claim ‘query application’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow initiating a query application as taught by Bartholomew. The motivation for the modification is to have the initiation in order to get the target person.

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Ljungqvist further fails to teach, "upon detecting said further spoken response during the playing of said prerecorded greeting prompt, terminating the playing of said prerecorded prompt". Bartholomew teaches upon detecting the further spoken response during the playing of the instruction, terminating the playing of instruction (col.44, lines 1-12, 31-63, col.45, lines 28-52, col.46, lines 1-5; 'instruction' reads on the claim 'prerecorded greeting prompt'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist to allow initiating a query application as taught by Bartholomew. The motivation for the modification is to have the initiation in order to get the target person.

Ljungqvist further teaches an answering machine has been detected (fig.3; page 18, lines 19-26).

12. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al.(U.S. Patent No. 4,761,807) and in view of Bartholomew et al.(U.S. Patent No. 6,167,119) and further in view of Brown et al.( U.S. Patent No. 5,333,180) and further in view of Szlam et al.( U.S. Patent No. 5,828,731).

Regarding claim 23, Ljungqvist in view of Bartholomew fails to teach "attempting to detect a beep tone during the playing of said prerecorded greeting prompt and, upon the detection of a beep tone, interrupting the prerecorded greeting prompt". Brown teaches tone prompting for the recording of the recipient's response during playing an announcement and upon detecting the tone, inherently interrupting the announcement (fig.4; col.14, lines 45-66; 'tone prompting for the recording of the recipient's response' reads on the claim 'detect a beep tone' and 'announcement' reads on the claim 'said prerecorded greeting prompt'). Thus, it would have been obvious to one

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of ordinary skill in the art at the time the invention was made to modify Ljungqvist in view of Bartholomew to allow detecting a beep tone and interrupting the prerecorded greeting prompt as taught by Brown. The motivation for the modification is for doing so in order to provide the option to leave the message for the desired person.

However, Ljungqvist in view of Bartholomew further in view of Brown fails to teach “playing a prerecorded answering machine message prompt”. Szlam teaches that answering machine answers the call (fig.1; col. 5, lines 4-23; ‘answering machine answers the call’ reads on the claimed ‘playing a prerecorded answering machine message prompt’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist in view of Bartholomew further in view of Brown to play a prerecorded answering machine message prompt as taught by Szlam. The motivation for the modification is to play the prompt in order to ask the calling party to leave the message for the called party.

Regarding claim 24, Ljungqvist in view of Bartholomew fails to teach “attempting to detect a beep tone during the playing of said prerecorded answering machine message prompt and, upon the detection of a beep tone, interrupting said prerecorded answering machine message prompt”. Brown teaches tone prompting for the recording of the recipient's response during playing an announcement and upon detecting the tone, inherently interrupting the announcement (fig.4; col.14, lines 45-66; ‘tone prompting for the recording of the recipient's response’ reads on the claim ‘detect a beep tone’ and ‘announcement’ reads on the claim ‘said prerecorded answering machine message prompt’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist in view of Bartholomew to allow detecting

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a beep tone and interrupting the prerecorded greeting prompt as taught by Brown. The motivation for the modification is for doing so in order to provide the option to leave the message for the desired person.

However, Ljungqvist in view of Bartholomew further in view of Brown fails to teach "replaying said prerecorded prompt". Szlam teaches that answering machine answers the call (fig.1; col. 5, lines 4-23; 'answering machine answers the call' reads on the claimed 'replaying said prerecorded prompt'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ljungqvist in view of Bartholomew further in view of Brown to replay a prerecorded answering machine message prompt as taught by Szlam. The motivation for the modification is to replay the prompt in order to ask the calling party to leave the message for the called party.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gallick (U.S. Patent No. 6,678,359) teach Called party identification in packet switched networks.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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M.E.

MD SHAFIUL ALAM ELAHEE  
August 23, 2004

Allan Hoosain  
ALLAN HOOSAIN  
PRIMARY EXAMINER for  
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